

REMARKS

Claims 1-24 and 26 are pending in the application. Claims 1, 5, 8, 14, 17, and 21 are independent. In the present paper, claims 1, 5, 8, 14, 17, and 21 have been amended and claim 25 has been canceled. These changes are believed to introduce no new matter and their entry is respectfully requested.

Rejection of Claims 5-11 Under 35 U.S.C. §101

In paragraph 2 of the Office Action, the Examiner rejected claims 5-11 under 35 U.S.C. §101 as being directed to a non-statutory process. Specifically, the Examiner states that while the claims recite a series of steps or acts to be performed, a statutory process under 35 U.S.C. §101 must either be tied to a particular machine or transform underlying subject matter to a different state or thing. The Examiner rejects claim 5 asserting that claim 5 does neither, and rejects dependent claims 6-11 based on their dependency from claim 5. Applicant respectfully traverses the rejection.

Although Applicant believes claims 5-11 are patentable as written, Applicant has amended claim 5 to recite “A method *performed by an audio/video apparatus*” (emphasis added). As such claim 5 currently recites statutory subject matter. Claims 6-11 include this feature by virtue of their dependency on claim 5. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 5-11.

Rejection of Claims 1-4 and 8-26 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1-4 and 8-26 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,185,228 to Takashimizu et al. (hereinafter “*Takashimizu*”), in view of U.S. Patent Publication No. 2005/02101390 to Kikuchi et al. (hereinafter “*Kikuchi*”), in further view of U.S. Patent No. 5,805,602 to Cloutier et al. (hereinafter “*Cloutier*”). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143 *citing In re*

Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int'l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain the reasoning that provides a nexus between the factual findings and the legal conclusion of obviousness. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationales and the findings of fact that must be made under the particular rationale. Applicants respectfully note, however, that no matter which rationale is used the burden still remains on the Examiner to demonstrate each prong of the *three-part test*: (1) that each and every element is taught; (2) that one skilled in the art could have combined the references; and (3) that there is predictability/expectation of success.

The Combination of *Takashimizu, Kikuchi, and Cloutier* Does Not Disclose Each and Every Element of Claims 1, 8, 14, 17, and 21

Independent claim 1 recites in pertinent part “a first circuitry coupled to select transport packets from a Transport Stream, the selected packets being only those identified with a Program Clock Reference Packet Identifier (PCR PID) and that include a Program Clock Reference (PCR) sample in an adaptation field, and to select from the Transport Stream transport packets identified with audio Packet Identifiers (PID); and a second circuitry coupled to *deliver only the selected transport packets to an audio processor across at least one of a bandwidth-limited link or a Bluetooth link*” (emphasis added). Independent claims 8, 14, 17, and 21 recite similar language. Support for these changes can be found in dependent claim 25, thus no new search is required.

In the Office Action, the Examiner asserts that *Takashimizu* discloses an apparatus, method, and computer-readable medium comprising a first circuitry coupled to select transport packets from a Transport Stream, the selected packets being only those identified with a Program Clock Reference Packet Identifier (PCR PID) and to select from the Transport Stream transport packets identified with audio Packet Identifiers (PID). The Examiner asserts further that *Takashimizu* discloses “second circuitry coupled to deliver the selected transport packets to an audio processor.” The Examiner concedes that *Takashimizu* fails to disclose that the selected packets are only those identified with a PCR ID and that include a PCR sample in an adaptation field, and to deliver only the selected transport packets to an audio processor.

The Examiner cites *Kikuchi* however for disclosing selecting transport packets from a Transport Stream, the selected transport packets being only the transport packets that include a Program Clock Reference Packet Identifier (PCR) and audio transport packets and delivering only the selected audio transport packets and the selected PCR transport packets to an audio processor. The Examiner cites *Cloutier* for disclosing a jitter correction device 122 as receiving an MPEG-encoded data stream carrying PCR data. The Examiner asserts that device 122 includes a PCR detector 124 that detects each occurrence of a PCR value in the MPEG stream and identifies the occurrence of the PCR value in the optional adaption field by reading the adaptation field control to determine whether an optional adaption field is present.

The Examiner cites *Cloutier* for disclosing a jitter correction device that detects a PCR value in an MPEG stream. The Examiner then determines that (1) it would have been obvious that *Takashimizu*'s MPEG-2 decoder 405 may be modified to perform the functions of *Kikuchi*'s MPEG-2 decoder 200, i.e., delivering only the selected audio and PCR transport packets to an audio processor and (2) to include the PCR detector 124 or jitter correction device 122 of *Cloutier* into *Takashimizu*'s device. The Examiner reasons that one would be motivated to make these modifications to enable *Takashimizu* to identify the occurrence of the PCR value in the adaptation field and to initiate corrective action in response to detected jitter. Applicant respectfully disagrees.

Applicants respectfully submit that *Takashimizu* in view of *Kikuchi* in further view of *Cloutier* fails to disclose a second circuitry coupled to *deliver only the selected transport packets to an audio processor across at least one of a bandwidth-limited link or a Bluetooth link*" as recited in independent claim 1. Because this amended subject matter came from dependent claim 25, Applicant will address the Examiner's rejection of dependent claim 25 here.

In the Office Action, the Examiner asserts with regard to claim 25 that *Takashimizu* in view of *Kikuchi* in further view of *Cloutier* discloses delivering the packets having an Adaptation Field and a PCR and the audio packets to an audio processor across at least one of a bandwidth-limited link or a Bluetooth link. The Examiner cites *Takashimizu*'s Fig. 1, stating that "D/A converter 407 outputs the audio signal via a bandwidth limited analog link to TV 410." Applicant respectfully disagrees.

Applicant respectfully submits that there is no express disclosure in *Takashimizu* that the link between the D/A converter 407 and the TV 410 is bandwidth limited. In fact, nowhere in *Takashimizu* is the term "bandwidth" mentioned. If the Examiner is asserting that it is inherent that the link between the D/A converter 407 and the TV 410 is bandwidth limited, then the Examiner must show that it necessarily flows from the disclosure of *Takashimizu* that the link between the D/A converter 407 and the TV 410 is bandwidth limited. (See To establish inherency, an Examiner must provide rationale or evidence tending to show inherency. MPEP §2112 IV. The extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (MPEP §2112IV citing *In re Oelrich*, 666 F.2d 578, 581-582 (CCPA 1981)). An Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art (emphasis in original). (MPEP §2112IV citing *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990))).

Applicant respectfully submits that because the Examiner has not demonstrated how the subject matter of claim 25 is disclosed expressly or inherently in *Takashimizu* the Examiner has not met the burden of proof. Applicant respectfully submits further that neither *Kikuchi* nor

Cloutier discloses the subject matter of claim 25. Moreover, the Examiner makes no such showing that *Kikuchi* or *Cloutier* discloses the subject matter of claim 25. As such, absent such a showing the burden has not been met and Applicant respectfully submits that claims 1, 8, 14, 17, and 21 are patentable over the combination of *Takashimizu* in view of *Kikuchi* in further view of *Cloutier*.

Claim 25 has been canceled rendering the rejection of it moot. Claims 2-4, 9-13, 15-16, 18-20, 22-24, and 26 properly depend from claims 1, 8, 14, 17, and 21, respectively, and are thus patentable for at least the same reasons that claims 1, 8, 14, 17, and 21 are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-4 and 8-26.

Rejection of Claims 5-7 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 5-7 under 35 U.S.C. §103(a) as being obvious over *Takashimizu* in view of *Kikuchi*. Applicant respectfully traverses the rejection.

Takashimizu in view of *Kikuchi* Does Not Disclose Each and Every Element of Claim 5

Independent claim 5 recites in pertinent part “delivering only the selected audio transport packets and the selected PCR transport packets to an audio processor *across at least one of a bandwidth-limited link and a Bluetooth link*” (emphasis added). Support for these changes can be found in dependent claim 25, thus no new search is required.

In the Office Action, the Examiner essentially makes the same arguments with regard to claim 5 as are made with regard to the remaining independent claims. Applicant again respectfully disagrees. Applicant further offers why claim 5 now amended with the subject matter of claim 25 is patentable over *Takashimizu* in view of *Kikuchi*.

In the Office Action, the Examiner asserts with regard to claim 25 that *Takashimizu* in view of *Kikuchi* in further view of *Cloutier* discloses delivering the packets having an Adaptation Field and a PCR and the audio packets to an audio processor across at least one of a bandwidth-limited link or a Bluetooth link. The Examiner cites *Takashimizu*’s Fig. 1, stating that “D/A

converter 407 outputs the audio signal via a bandwidth limited analog link to TV 410.” Applicant respectfully disagrees.

Applicant respectfully submits that there is no express disclosure in *Takashimizu* that the link between the D/A converter 407 and the TV 410 is bandwidth limited. In fact, nowhere in *Takashimizu* is the term “bandwidth” mentioned. If the Examiner is asserting that it is inherent that the link between the D/A converter 407 and the TV 410 is bandwidth limited, then the Examiner must show that it necessarily flows from the disclosure of *Takashimizu* that the link between the D/A converter 407 and the TV 410 is bandwidth limited. (See To establish inherency, an Examiner must provide rationale or evidence tending to show inherency. MPEP §2112 IV. The extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (MPEP §2112IV citing *In re Oelrich*, 666 F.2d 578, 581-582 (CCPA 1981)). An Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art (emphasis in original). (MPEP §2112IV citing *Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990))).

Applicant respectfully submits that because the Examiner has not demonstrated how the subject matter of claim 25 is disclosed in *Takashimizu* the Examiner has not met the burden of proof. Applicant respectfully submits further that neither *Kikuchi* nor *Cloutier* discloses the subject matter of claim 25. Moreover, the Examiner makes no such showing that *Kikuchi* or *Cloutier* discloses the subject matter of claim 25. As such, absent such a showing the burden has not been met and Applicant respectfully submits that claims 1, 8, 14, 17, and 21 are patentable over the combination of *Takashimizu* in view of *Kikuchi* in further view of *Cloutier*.

Claims 6-7 properly depend from claim 5, and are thus patentable for at least the same reasons that claim 5 is patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 5-7.

CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

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Date

1279 Oakmead Parkway
Sunnyvale, CA 94085-4040
(206) 292-8600

/Jan Little-Washington/
Jan Little-Washington
Reg. No. 41,181

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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below.

/Kristy A. Marvel/ June 24, 2009
Kristy A. Marvel Date